

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

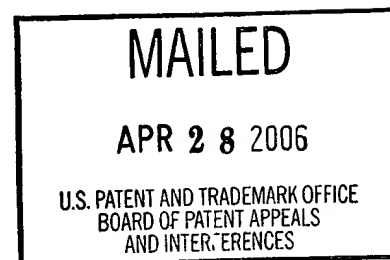
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ISABELLE AFRIAT

Appeal No. 2005-2743
Application No. 09/847,388

ON BRIEF¹



Before ADAMS, MILLS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-20, 35,36 and 43-47, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A cosmetic, skincare or make-up composition comprising fibers and at least one active agent for treating greasy skin, wherein the at least one active agent is selected from the group consisting of β -lactam derivatives; quinolone derivatives; ciprofloxacin; norfloxacin; tetracycline and its salts; erythromycin and its salts; amikacin and its salts; 2,4,4'-trichloro-2'-hydroxydiphenyl ether; 3,4,4'-trichlorocarbanilide; phenoxypropanol; phenoxyisopropanol; doxycycline and its salts; capreomycin and its salts;

¹ In accordance with 37 CFR § 41.73(f), the Board decided that an oral hearing was not necessary in this appeal.

chlortetracycline and its salts; oxytetracycline and its salts; clindamycin and its salts; ethambutol and its salts; hexamidine isethionate; metronidazole and its salts; pentamidine and its salts; gentamicin and its salts; kanamycin and its salts; lineomycin and its salts; methacycline and its salts; methenamine and its salts; minocycline and its salts; neomycin and its salts; netilmicin and its salts; paromomycin and its salts; streptomycin and its salts; tobramycin and its salts; miconazole and its salts; amantadine salts; para-chloro-metaxilenol; nystatin; tolnaftate; 3-hydroxybenzoic acid and its salts; 4-hydroxybenzoic acid and its salts; 2-hydroxybutanoic acid and its salts; 2-hydroxypentanoic acid and its salts; 2-hydroxyhexanoic acid and its salts; phytic acid and its salts; N-acetyl-L-cysteine acid and its salts; lipoic acid and its salts; azelaic acid and its salts; arachidonic acid and its salts; ibuprofen; naproxen; hydrocortisone; acetaminophen; resorcinol; octopirox; lidocaine hydrochloride; clotrimazole; 10-hydroxy-2-decanoic acid and its salts; zinc gluconate; plant extracts from the ericacea family; sulphur-rich plant extracts; and mixtures thereof.

The references relied upon by the examiner are:

Sebillotte-Arnaud	5,814,322	Sep. 29, 1998
Castro et al. (Castro)	6,306,407	Oct. 23, 2001

GROUND OF REJECTION

Claims 1, 3-20, 35, 36 and 43-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Castro in view of Sebillotte-Arnaud.

We reverse.

DISCUSSION

According to the examiner (Final Rejection², page 2), Castro teaches a cosmetic or pharmaceutical composition comprising fibers. In this regard, the examiner finds (*id.*, emphasis removed), "when applied to the skin[, the composition,] provides a layer of fibers having moisture and oil regulating

² The Final Rejection was mailed August 19, 2003.

properties.” Nevertheless, while Castro discloses the benefit of using the fiber containing composition for therapeutic purposes, Castro fails to teach a fiber containing composition that also contains any of the active agents set forth in appellant’s claimed invention. Final Rejection, page 4.

To make up for this deficiency the examiner relies on Sebillotte-Arnaud. According to the examiner (id., emphasis removed), “Sebillotte-Arnaud teaches compositions containing a cosmetically and/or dermatologically acceptable hydrophilic medium, water and optionally an active agent which makes it possible in particular to prevent and/or control pigmentation of the skin or to control greasy skin....” In this regard, the examiner finds (Final Rejection, bridging paragraph, pages 4-5 emphasis removed), “Sebillotte-Arnaud discloses that active agents which can be dissolved in the composition, [include] ... octopirox, erythromycin, clindamycin, miconazole, ... and anti-inflammatories such as hvdrocortisone, etc....”

Based on this evidence, the examiner concludes (Final Rejection, page 5) that given Castro’s fiber containing composition utility in controlling oil and moisture on the skin, it would have been prima facie obvious at the time appellant’s invention was made to “have looked in the art for specific active agents for treating greasy skin” that could be added to Castro’s composition. As we understand the examiner’s reasoning, upon considering the prior art, a person of ordinary skill would turn to the disclosure of Sebillotte-Arnaud for a teaching of active agents that could be added to Castro’s composition for treating greasy skin.

However, as appellant points out (Brief, page 3), “[t]he [e]xaminer’s combination of Sebillotte-Arnaud’s active agents with Castro’s compositions is exactly the type of combination which Sebillotte-Arnaud had found to be problematic and which Sebillotte-Arnaud was trying to avoid.” Stated differently, appellant asserts (id.), Sebillotte-Arnaud teaches away from a combination with Castro. In this regard, appellant points out (Brief, page 4), “Castro’s fibers are present in an oil carrier [and] suggests adding oil-soluble active agents to his compositions, but not water-soluble active agents.”³ Stated differently, “Castro discloses compositions (for example, emulsions) in which fibers and ‘active agents’ (if present) are in the oil phase or an oil carrier.” Id.

In contrast, among a number of reasons Sebillotte-Arnaud teach away from the use of water-in-oil or oil-in-water emulsions (column 1, lines 25-57), as taught by Castro, Sebillotte-Arnaud discloses (column 1, lines 25-46),

[c]ompositions conventionally used in the cosmetic ... fields are water-in-oil (W/O) emulsions, oil-in-water (O/W) emulsions or aqueous gels, in which it is often difficult, indeed even impossible, to incorporate certain active agents.... In general, these active agents have a tendency to recrystallize or to degrade. The result is a more or less significant loss in the efficacy of these compositions, according to the degree of recrystallization and/or degradation, which runs counter to the desired objective. In addition, this recrystallization or degradation can modify the overall stability of these compositions and their appearance, which can turn the user away from these specific treatment compositions. Moreover, to dissolve such active agents in some compositions often requires heating the latter, which is relatively troublesome for active agents which are sensitive to heat....

³ The examiner concedes this point (Final Rejection, page 4), “Castro discloses additional preferred components of the cosmetic compositions including ... oil-soluble actives such as tocopherol and its derivatives, retinol and its derivatives, and the like....”

As appellant points out (Brief, page 4), “Sebillotte-Amaud’s solution to this problem is a [stable] gel composition containing a hydrophilic medium or carrier, not a conventional oil-containing composition such as an emulsion.” Based on this analysis of the references, appellant reasons (id., emphasis removed),

[g]iven that Sebillotte-Arnaud found that his active agents were stable in a gel containing a hydrophilic carrier but were not stable in other types of compositions, one skilled in the art would not have been motivated to use such active agents in a composition which did not possess a hydrophilic carrier because no expectation would have existed that the resulting active agent-containing composition would be stable.

In response, the examiner argues (Answer, page 5), “one of ordinary skill would be motivated to add other active agents [to Castro’s composition] to obtain a dual effect.” While this may be true, we fail to understand why a person of ordinary skill in the art would select an active agent, such as those taught by Sebillotte-Amaud, which would be difficult, or impossible to incorporate into the emulsion taught by Castro. Further, we recognize the examiner’s argument (Answer, bridging paragraph, pages 5-6), “[r]etinols[, as taught by Castro] and azelaic acid[, as set forth in appellant’s claims], although chemically different agents, are known in the art for combating acne and related skin disorders ... [c]learly one of ordinary skill in the art would be able to substitute one for the other.” However, while Castro teaches retinols, retinols are not included in appellant’s claimed listing of active agents. In addition, while appellant’s claims identify azelaic acid as an active agent, neither Castro nor Sebillotte-Amaud teach azelaic acid. Accordingly, we are not persuaded by the examiner’s argument.

We are also not persuaded by the examiner's assertion that oils and lipophilic agents can be added to the Sebillotte-Amaud composition. As we understand the examiner's statement of the rejection, Sebillotte-Amaud is relied upon to teach active agents that can be added to the composition taught by Castro. Accordingly, it is unclear why the examiner has addressed other ingredients that may be present in the Sebillotte-Amaud composition. The examiner provides no evidence that the presence of these other ingredients transforms the Sebillotte-Amaud composition into an emulsion similar to Castro's composition. Accordingly, there is no evidence of record to rebut appellant's assertion that a person of ordinary skill in the art would not turn to Sebillotte-Amaud to select active agents that could be added to the composition taught by Castro.

As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

...

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. ... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. ... Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the

desirability of making the specific combination that was made by the applicant. [Citations omitted].

In other words, "there still must be evidence that 'a skilled artisan, ... with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.'" Ecolochem Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075-76 (Fed. Cir. 2000). At best, the statement of the rejection establishes that individual parts of the claimed invention were known in the prior art. For the foregoing reasons, however, it is our opinion that there is no motivation to combine the references as relied upon by the examiner.

Accordingly, we reverse the rejection of claims 1, 3-32 and 34-47 under 35 U.S.C. § 103(a) as being unpatentable over Castro in view of Sebillotte-Arnaud.

OTHER ISSUES

Having reversed the only rejection of record, we make the following observations. Prior to taking any further action on the merits we encourage the examiner to take a step back and consider the following observations.

I. What types of compositions can fibers be used in?

According to Castro (column 2, lines 43-44), the use of fibers in cosmetic compositions is art recognized. In this regard, Castro refers to United States Patent 4,820,510 and "JP 7179323." Id., line 44. Given that fibers are used in cosmetic compositions, would it have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the composition taught by

Sebillotte-Arnaud to include fibers, as taught by Castro? Upon review of the prosecution history, it does not appear that the prior art was considered in this manner. Accordingly, the record was not sufficiently developed to allow this panel to address this issue. However, prior to taking any further action on the merits, we encourage the examiner to take a step back and reconsider the claimed invention in light of the prior art.

II. Active agents useful in emulsions:


From a review of the prosecution history, it is unclear whether the examiner considered whether the prior art taught emulsions containing active agents within the scope of appellant's claimed invention. In this regard, we direct attention to the examiner's discussion of retinols and azelaic acid. Answer, bridging paragraph, pages 5-6. According to the examiner (id.), "although chemically different agents, [retinols and azelaic acid] are known in the art for combating acne and related skin disorders thus ... one of ordinary skill in the art would be able to substitute one for the other." If the examiner is correct in that the prior art recognizes the two compounds to be equivalent, an express suggestion to substitute one for another need not be present in order to render such substitution obvious. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982). We note, however, that in order to substitute azelaic acid for the retinol taught by Castro, the prior art would have to not teach away from the use of azelaic acid in an emulsion as taught by Castro.

Accordingly, prior to taking any further action on the merits we encourage the examiner to take a step back and reconsider the claimed invention in light of the relevant prior art.

III. Manual of Patent Examining Procedure (MPEP) § 706.02(j):

As presented for our review, the rejection of record encompassed a plurality of claims but did not state with any specificity why any individual claim is unpatentable. In the event of further prosecution, if the examiner maintains a rejection under 35 U.S.C. § 103, we suggest the examiner review MPEP § 706.02(j) for a model of how to explain a rejection under this section of the statute. Adherence to this model will of necessity require that the examiner consider the patentability of the claims in an individual manner and set forth the facts and reasons in support of why individual claims are unpatentable.

REVERSED



Donald E. Adams
Administrative Patent Judge



Demetra J. Mills
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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